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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,556	07/31/2001	Erik G. Burrows	2099	4926

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GATEWAY, INC.
ATTN: SCOTT CHARLES RICHARDSON
610 GATEWAY DR., Y-04
N. SIOUX CITY, SD 57049

EXAMINER

SORRELL, ERON J

ART UNIT PAPER NUMBER

2182

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,556	Applicant(s) BURROWS, ERIK G.	
	Examiner Eron J Sorrell	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/31/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6, 7-12, 13-16, and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-8, 11-15, and 18-21 of copending Application No. 09/994,353. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the instant application necessarily imply the reception of a selected feature in the limitation of "analyzing a **selected feature** to be operable from said list (emphasis added)," and application 09/994,353 has a positive recitation of receiving a selected feature. In the instant application, a selected

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feature would have to be received before it could be analyzed. The respective dependent claims of both application recite identical limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "There is no mention in the specification of playing media content operably connected to an assembly means."

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5. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no mention in the specification of "playing media content operably connected to an assembly means."

6. It appears to the Examiner that claim 19 was inadvertently included in the instant application and should simply be cancelled by the applicant.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1-4, 7-10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (US 2003/0028650 hereinafter "Chen").

9. Referring to method claim 1, program on computer readable medium claim 7, and apparatus claim 13, Chen teaches a method and apparatus for assigning internet protocol address comprising:

identifying hosts present within a local network (see paragraph 76 on page 7);

providing a list of available features for at least one host within said local network (see paragraphs 79-80 on page 7 note the features are the type of connections available);

analyzing a selected feature to be operable from said list (see paragraphs 79-80 on page 7); and

assigning an Internet protocol address to said at least one host, wherein a static Internet protocol address is assigned to said at least one host if said selected feature requires said static Internet protocol address (see figures 8 and 14 and paragraph 85 on page 8).

10. Referring to method claim 2, program on computer readable medium claim 8, and apparatus claim 14, Chen teaches the list is

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provided in a graphical user interface (see figure 8 and paragraphs 79-80 on page 7).

11. Referring to method claim 3, program on computer readable medium claim 9, and apparatus claim 15, Chen teaches the selected feature is capable of being selected by a user utilizing said graphical user interface (see paragraphs 79-80 on page 7).

12. Referring to method claim 4, program on computer readable medium claim 10, and apparatus claim 16, Chen teaches the assigning of the Internet protocol address is in accordance with Dynamic Host Configuration Protocol (see paragraph 80 of page 7).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 5,6,11,12,17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Hall (US 2002/0138614).

15. Referring to method claims 5, program on computer readable medium claim 11, and apparatus claim 17, Chen fails to teach the static Internet protocol address is generated by continually reassigning an address in accordance with Dynamic Host Configuration Protocol.

Hall teaches in an analogous method and apparatus the above limitation (see paragraph 21 of page 2) are part of the DHCP specification.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and apparatus of Chen with the above teachings of Hall. One of ordinary skill in the art would have been motivated to make such modification in order to comply the DHCP specification as suggested by Hall (See paragraph 21 of page 2).

16. Referring to method claims 5, program on computer readable medium claim 11, and apparatus claim 17, the static Internet protocol address is returned to a pool of available addresses if

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said selected feature requiring the static Internet protocol address is disabled (see paragraph 68 on page 6).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show the state of the art as it pertains to IP address assignment in a network:

US 2003/0195954 to Bahlmann teaches distinguishing when to configure a device with a static or dynamic IP address;

US Patent 6,289,378 to Meyer et al. teaches a system wherein computers are configured by another computer on a local area network via a graphical user interface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

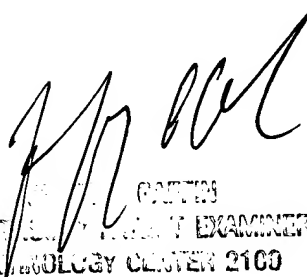
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 571 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS

November 8, 2004


SUPERVISING PATENT EXAMINER
TECHNOLOGY CENTER 2100